



**UNITED STATES DEPARTMENT OF COMMERCE**  
**Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/337,584 06/21/99 KRIEG

A C1039/7020-H

HM12/0921

HELEN C LOCKHART  
WOLF GREENFIELD & SACKS PC  
600 ATLANTIC AVENUE  
BOSTON MA 02210

EXAMINER

MARTINELL, J

ART UNIT

PAPER NUMBER

1633

DATE MAILED:

09/21/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/337,584**

Applicant(s)  
**Krieg et al**

Examiner  
**James Martinell**

Group Art Unit  
**1633**



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1 and 42-89 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1 and 42-89 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Serial No. 09/337,584

Art Unit 1633

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1, drawn to oligonucleotides, classified in class 536, subclass 23.1.
- II. Claims 42-89, drawn to methods of treating cancer and allergies using oligonucleotides, classified in class 514, subclass 44.

The inventions are distinct, each from the other for the following reasons. The oligonucleotides of Group I have uses other than those of Groups II and III. For example, the oligonucleotides of Group I may be used in affinity chromatography.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and because of their recognized divergent subject matter restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to

Serial No. 09/337,584

Art Unit 1633

be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Applicants should note that claims 61 and 62 depend from cancelled claim 25.

Claims 57-59 and 78-82 contain nucleotide sequences that are not identified by SEQ ID NOs as is required in 37 CFR § 1.821(d). Appropriate correction is required for any response to this Office action to be considered a complete response.

Certain papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Art Unit 1633 at (703) 308-4242. The faxing of such papers

Serial No. 09/337,584

Art Unit 1633

must conform with the rules published in the Official Gazette,  
1156 OG 61 (November 16, 1993).

Any inquiry concerning this communication should be directed  
to J. Martinell at telephone number (703) 308-0296.

  
JAMES MARTINELL, Ph.D.  
SENIOR LEVEL EXAMINER